



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,455	10/16/2003	Paul Lapstun	NPA127US	5430
24011	7590	09/29/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,455

Applicant(s)

LAPSTUN ET AL.

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/16/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 8-31, 36-43, 45-46 and 48 of copending Application No. 09/608022. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences, such as providing a form to an auction buyer and identifying a unique location of each of the reference points relative to the form are obvious variations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2.1. Claims 1-15, 18-20, 22-31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al (US Patent 6,081,261) in view of Patterson, Jr. et al (US Patent 5,797,002).

Regarding claim 1, Wolff discloses a method of enabling a buyer to submit a bid, the method including the steps of: providing the auction buyer with a form containing information relating to a bid transaction, the form including coded data indicative of at least one parameter of the bid transaction; receiving, in a computer system, data from a sensing device regarding said at least one parameter and regarding movement of the sensing device relative to the form, the sensing device, when moved relative to the form; sensing the data regarding said at least one parameter using at least some of the coded data and generating the data regarding its own movement relative to the form; and interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter (See Wolff at least col.1, line 30-col.4, line 38. Quote:

", users can readily create or manipulate paper documents while simultaneously making corresponding electronically-coded images of the same created or manipulated paper document. This is accomplished by means of a hand-held, pen-like instrument that can write on paper documents, simultaneously sense the writing, and interpret and enter the written markings in the electronically-coded document. Also, image sensing allows the system to identify the type of document being subjected to manually-written modifications.(a) a physical document page with a surface suitable to be written upon that can also contain pre-printed document information; (b) a pen-instrument for writing on the physical document surface, the pen-instrument having suitable transducers for sensing both the written data(c) a base unit for receiving the transducer data and converting the transducer data to binary digital information suitable for processing in the base unit CPU, or another computer, for document identification and for incorporating the written information with the pre-printed document information.Forms Processing: filling out of a prescribed form would automatically cause the generation of a corresponding electronic form, the paper version being kept, as needed, for legal or safety reasons. A significant cost reduction in computer data entry results.Document Editing: any paper document can be edited by crossing-out words, and by the use of typographic notation for other editing operations, or annotated, or sent elsewhere. The paper modifications immediately affect the electronic version so that the electronic version can serve as the true source document because any access of, or communications of, that document would reflect all edits or annotations. Document Retrieval: searching of electronic databases by writing or circling a few keywords, thumbnail descriptions, or by drawing pictures, which, when interpreted, provide the data location. ...Note Book: using the pen-instrument for writing notes on paper and for electronically retrieving notes previously written on paper and stored from a sequentially ordered (and/or an otherwise organized) electronic memory file..... Digitally coded information is printed on each page so that the pen-instrument can be used to read the pertinent digital code that identifies the page format and the segments of calendar time spanned by the CB page.The graphical display can provide immediate feedback by use of an optional cathode ray tube (CRT) display. The feedback can be a simple recreation of the written message by using pen-instrument positional writing point pressure data or the interpreted written message from a cursive character recognition device using the same data.

In the latter case, incorrectly recognized written data can be scratched-out or over-written.

FIG. 2 is a flow diagram describing the basic operating mode of a particular CB. The operation begins at step 500 where it is assumed that a fixed format has been prescribed and its description is stored with the configuration information for that CB. Configuration data includes calendar type, chronology layout defining time intervals, segments, and writing spaces. Also, a user list is stored against which the bar-code I.D. can be checked for validity.At step 501, the computer checks if the pen-instrument is moving horizontally, indicating that a CB operation is about to be initiated by reading the bar-code located in area 13. If not, the system goes into a wait loop in which the pen-instrument motion is monitored. If the appropriate horizontal motion is detected, the process proceeds to step 502 in which the bar-code I.D. is read by scanning bar-code area 13 with the pen-instrument. If a valid bar code signal results, step 503 moves the process to step 505, otherwise the process goes to step 504 where an audible and/or visual alarm is set for informing the user that access is denied and the system returns to step 501. The bar-code can also be compared with a list of authorized codes and if a match exists the CB access request is validated and proceeds to step 505. At this juncture, the pen-instrument user may try to read the bar-code again or investigate the system for the cause of the misread bar-code data. ". Unquote.

As disclosed above, the pre-printed coded form or CB page in Wolff represent a printed form as claimed in the applicant's invention. Wolff does not expressly teach that the encoded data in the form contains information relating to bid transactions. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The providing, receiving and interpreting steps would be performed the same regardless of the *data contained in the pre-printed forms, that is if data is related to a calendar book, bid transaction, or any other data*. Thus, this *descriptive material* will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to contain any type of *data* in the pre-printed form and provide it to a variety type of users depending upon their intended uses, such as, a pre-printed form for maintaining appointments information, filling out any prescribed form, editing a form, as disclosed in Wolff or for other uses as well like using a pre printed form for bid transaction for auction buyer , etc. because such *data* does not *functionally* relate to the steps in the method claimed and because the subjective interpretation of the *data* does not patentably distinguish the claimed invention.

However, Patterson, in the analogous field of transferring orders, quotes and memos by using pen-type input devices, discloses the steps wherein electronic forms contain information relating to a bid transaction being provided to a user and the coded data being sensed includes at least one parameter relating to the bid transaction (See col. 13 line 20 – col. 15 line 55). The step where the user is an auction buyer is old and well-known in the art. It would have been obvious to one of an ordinary skill in the art at the time of invention to include these steps taught by Patterson to the invention of Wolff. The combination of the disclosures taken as a whole suggests that auction buyers would have benefited from being able to use a using a printed form, electronically storing its contents and quickly retrieving its contents as needed.

Regarding claims 2 and 3, Wolf in view of Patterson discloses a method of enabling an auction buyer to submit a bid as applied to claim 1. Patterson further discloses claims that the parameter is an action parameter of the bid transaction, the method including effecting, in the computer system, an operation in respect of the action parameter including placing a bid (See at least Patterson col. 13 lines 20-32).

Regarding claim 4, Wolff in view of Patterson discloses a method of enabling an auction buyer to submit a bid as applied to claim 1. Patterson further discloses, in which the parameter is an option parameter of the bid transaction, the method including identifying, in the computer system, that the buyer has entered a hand-drawn mark by means of the sensing device and effecting, in the computer system, as operation associated with the option parameter (See at least Patterson Figures 4, 8, 11 and col.12, line 20-col.15, line 55).

Regarding claim 5, Wolff in view of Patterson discloses a method of claim 4 in which respectively, in which the option parameter is associated with placing a bid (See at least Patterson Figures 4, 8, 11 and col.13, line 20-col.15, line 55).

Regarding claims 6-7, Wolff in view of Patterson discloses a method of claim 1, in which the parameter is a text parameter of the bid transaction, the method including identifying, in the computer system, that the auction buyer has entered handwritten text data by means of the sensing device and effecting, in the computer system, an operation associated with the text parameter including converting, in the computer system, the handwritten text data to computer text (See at least Patterson Figures 4, 8, 11 and col.13, line 20-col.15, line 55).

Regarding claim 8, Wolff in view of Patterson discloses a method claims 7, in which the text parameter is associated with at least one of a name of the buyer, item search text, and a bid amount (See at least Patterson Figures 4, 8, 11 and Column 13 line 20 - Column 15 line 55).

Regarding claims 9-10, Wolff in view of Patterson discloses a method of claim 1 and Patterson further discloses that the parameter is an authorization parameter of the bid transaction, the method including identifying, in the computer system, that the auction buyer has entered a handwritten signature by means of the sensing device and effecting, in the computer system, an operation associated with the authorization parameter including verifying, in the computer system, that the signature is that of the buyer (See at least Patterson Figures 4, 8, 11 and Column 13 line 20 - Column 15 line 55). The verifying step is inherent in the disclosure of Patterson.

Regarding claim 11, Wolf in view of Patterson discloses a method of claim 10, in which the authorization parameter is associated with authorization of placing a bid (See at least Patterson Figures 4, 8, 11 and Column 13 line 20 - Column 15 line 55).

Regarding claims 12-14, Wolf in view of Patterson discloses a method of claim 1, in which the parameter is a picture parameter, an operation associated with the picture parameter, which in turn is associated with a picture of a listed item and that the form contains information relating to at least a listed item (See at least Wolff col.3, lines 15-20).

Regarding claim 15, Wolff in view of Patterson discloses a method of claim 1 which includes printing the form on demand (inherent in the disclosure of Wolff).

Regarding claims 18 and 20, Wolff in view of Patterson discloses that the method of claim 1 further includes distributing a plurality of the forms using a mixture of protocols (See at least Patterson col.19, lines 1 1-27 and col.23 lines 44-47) and including providing all

required information relating to the bid transaction in the form to eliminate the need for a separate display device (See at least Patterson Figures 4, 8, 11 and col.13, line 20 – col.16, line 55). The communications protocols are interpreted to include a mixture of multicast and pointcast communications protocols.

Regarding claim 19, Wolff in view of Patterson discloses that the claim 1 includes retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data and in which the sensing device contains an identification means which imparts a unique identity to the to the sensing device and identifies it as being associated with a particular auction buyer and in which the method includes monitoring, in the computer system), said identity (inherent in the disclosure of Wolff).

Regarding claims 22-28, and 30-31, their limitations are closely parallel to the limitations of claims 1-3, 5, 8, 11, 13, 19, and 15 respectively and are therefore analyzed and rejected on the same basis.

Regarding claim 29, Wolff in view of Patterson as applied to claim 22 teaches that the sensing device includes a marking nib (see at least col.7, lines 6-14, “ *providing a writing point that deposits ink[or other writing medium] on to paper surface by contact.....* ”).

2.2. Claims 16-17, 21, and 32-35 are rejected under 35 U.S.C. 103(a) as being obvious over Wolff in view of Patterson and further in view of Official Notice.

Regarding claims 16-17 and 21, Wolff in view of Patterson discloses a method of claim 15 which includes printing the form on demand and printing the form on a surface of a surface-defining means (inherent in the disclosure of Wolff). Wolff in view of Patterson combined do not explicitly disclose printing the coded data on a surface which is substantially invisible in the visible spectrum and printing of multiple pages and in which the method includes binding the pages.

Official notice is taken that printing the coded data on a surface, which is substantially invisible in the visible spectrum and printing of multiple pages and in which the method includes binding the pages is old and well-known in the art. Printing coded data on a surface, which is substantially invisible in the visible spectrum enhances the security of the codes being printed and printing on multiple pages and binding them helps keep the records together. It would have been obvious to one of an ordinary skill in the art at the time of invention to include the step of printing the coded data on a surface, which is substantially invisible in the visible spectrum to the disclosure of Wolff in view of Patterson as applied to claim 1. The combination of the disclosures taken as a whole suggests that users would have benefited from the enhancement of security of the codes which are printed and keeping the records together by printing on multiple pages and binding them.

Regarding claims 32-33 and 35, their limitations are closely parallel to the limitations of claims 16-17 and 21 and are therefore analyzed and rejected on the same basis.

Regarding claim 34, Wolff in view of Patterson as applied to claim 33 further discloses retaining a retrievable record of each form generated, each form being retrievable by using its

identity as included in its coded data (Inherent in disclosure of Wolff)..

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patents 6,666,376 B1 to Ericson, see at least, col.1, line 45-col.6, line 23, and 6,456,749 to Kasabach et al., see at least col.3, line 8-col.8, line 52, disclose methods enabling an user for recording calendar information in a digital storage medium. The methods include a calendar in the shape of pre-printed forms with encoded data and comprise plurality of pages with plurality of reference points on these pre-printed forms and each of the reference points identifies a unique location relative to the form. The methods further suggest receiving, in a computer system, indicating data using a sensing device regarding the identity of a printed paper form and a position of the sensing device relative to the printed form. Ericson and Kasabach inventions can be used to render the claims 1-35 of the instant application obvious in view of the references Patterson and Official Notice.

(ii) US Patent 6,766,304 B2 to Kemp, II et al. discloses a method and a system enabling an auction buyer to submit a bid (see at least abstract and col.1, line 55-col.12, line 27).

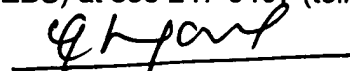
(iii) WO 98/08344 to Sachs et al. teaches a method and an apparatus for viewing electronic reading materials (see at least abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
September 21, 2004